

Turning now to the outstanding Office Action: Speaking generally, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the Office Action has identified separate classifications, making a *prima face* case of a serious burden, it is respectfully submitted that there is no serious burden in searching and examining the entire application.

Since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without significant additional effort. As patents and other publications in this art may contain descriptions of both a process of analyzing a device, and the device analyzed, information as to both process and device can be found in the same publication. Patents and publications directed to a process of analyzing a device may have descriptions of the device analyzed by the process, greatly facilitating the prior art search and the consideration of both device and process claims.

The PTO classification index found on the PTO web site shows a search of the two groups overlap, and the search notes for the subclasses related to those cited by the examiner refer to each other:

- The search notes to **Invention I**'s class 257, subclass 48 specifically directs an examiner to search class 438, subclass 18, which is close to subclass 11 which is the examiner's classification of **Invention II**.
- Conversely, the instructions for searching **Invention II**'s class 438, subclass 11 direct the examiner to search Class 257, subclass 48, which is the very subclass to which the examiner has assigned **Invention I**.

Thus, the search of the semiconductor device claims and the process claims will overlap with, if not cover, each other. There is little, if any, extra effort in searching and examining the process

claims compared to searching and examining the device claims, since the search areas overlap, even if the inventions of Groups I and II are distinct.

It is respectfully submitted that there is no *serious* burden to examine these claims, especially in view of the fact that the method claims are dependent on the device claims, and the method claims have the same bodies. Examination of all claims in this application is therefore believed to be proper, and reconsideration and withdrawal of the restriction requirement are respectfully requested.

Moreover, concerning the Requirement for Election of Species, Applicant submits that Claim 1 is generic: all claims depend, directly or indirectly, from Claim 1. Therefore, reconsideration and withdrawal of the Requirement for Election of Species are respectfully requested.

Accordingly, Applicants respectfully request that the Restriction Requirement and the Requirement for Election of Species be withdrawn, and that all pending claims be examined at this time. An early and favorable action on the merits of all claims is respectfully requested.

Respectfully submitted,

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